

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 10, 2006. At the time of the Office Action, Claims 1-19 were pending in this Application. Claims 10-13, 15, and 17-19 were withdrawn from further consideration as being drawn to a non-elected invention. Claims 1-9, 14 and 16 were rejected. Claim 1 has been amended. Claims 20-26 have been added. No new matter is presented by this amendment. Claims 10-13, 15 and 17-19 have been cancelled due to an election/restriction requirement. Applicants respectfully request reconsideration and favorable action in this case.

Election/Restriction Requirement

In the Office Action mailed January 10, 2006, the Examiner set forth an election restriction requirement of the claimed invention and species. Applicants made a provisional election with traverse to prosecute the invention of Species I, Claims 1-9, 14 and 16, drawn to FIGURE 1A. Applicants hereby confirm that election. Accordingly, Applicants hereby cancel Claims 10-13, 15 and 17-19 without prejudice or disclaimer and elect that the cancelled claims are subject to the filing of a divisional application.

Rejections under 35 U.S.C. § 102

Claims 1-6 and 14 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,387,086 issued to Jean-Marie Mathias et al. (“Mathias”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Mathias lacks various elements of independent Claims 1, 20 and 23. In particular, the component of Mathias the Examiner has identified as an “associating device” (components 68, 98 and 100, which are shown in Mathias Figure 4D), this component is not operable to “support the receptacle in the standby position” and “guide the receptacle to a transfer position.” The claim language indicates that there are two positions, a standby position and a transfer position. In the standby position, the receptacle is stored at the device without transfer of the biological fluid. In the transfer position, “the downstream end of needle 16 is in fluid communication with the inside of receptacle 15.” (See Specification, p. 8, lines 16-21 and Figure 1.)

Mathias does not disclose these two separate positions. In particular, when the element of Mathias resembling the receptacle of the present invention (element 70, as shown in Mathias Figures 3, 4B, 5A, 5B, 5C and 5D), is guided by positioning prongs 98 and 100, its closure has already been pierced by the needle (Mathias element 74). This feature of Mathias is described at Col. 7, lines 20-25 and is also shown in Mathias Figure 5D.

Applicants have amended Claim 1 to indicate that the receptacle is not pierced by a needle in the standby position and *is* pierced by a needle in the transfer position. This represents a structural feature of the receptacle not shown in Mathias.

Rejections under 35 U.S.C. §103

Claims 7-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of U.S. Patent No. 5,364,360 issued to Antonio G. Flumene et al. (“Flumene”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mathias in view of U.S. Patent No. 5,125,920 issued to Noboru Ishida (“Ishida”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In particular, Mathias fails to disclose system having both a standby and transfer position as described above. Neither Flumene nor Ishida disclose such a system.

Double Patenting Rejection

The Examiner provisionally rejected Claims 1-4 and 6 based on the judicially created double patenting doctrine over Claims 1-4, 14-16, and 21 of co-pending Application 10/217,205 (hereinafter “‘205 application”) stating that the subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter.

Applicants respectfully traverse the rejection. No Claims of the ‘205 Application are directed to a system in which a receptacle may be held in a standby, then a transfer position. Further, the ‘205 Application does disclose any structure in which a receptacle may be supported by an associating device in a standby position in which it is not pierced by a needle. Accordingly, the ‘205 Application could not support any claims of the present application.

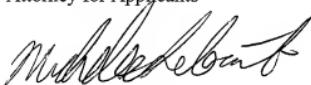
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2580.

Respectfully submitted,
BAKER BOTTs L.L.P.
Attorney for Applicants



Michelle M. LeCointe
Reg. No. 46,861

Date: 4/10/06

SEND CORRESPONDENCE TO:

BAKER BOTTs L.L.P.

CUSTOMER NO. **23640**

512.322.2580

512.322.8383 (fax)